SL

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,990	10/17/2001	Tomoaki Yoshida	740670-267	4491

7590 03/15/2004

NIXON PEABODY LLP
Suite 800
8180 Greensboro Drive
McLean, VA 22102

EXAMINER	
PSITOS, ARISTOTELIS M	
ART UNIT	**PAPER NUMBER**
2653	

DATE MAILED: 03/15/2004 5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/977,990	YOSHIDA, TOMOAKI	
	Examiner	Art Unit	
	Aristotelis M Psitos	2653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 October 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means as recited in claim 1 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

1. Claims 2-8 are objected to because of the following informalities:

Claim 2 recites in line 1, a "disk reproducing apparatus" and yet the remainder of the claim is written as a method. Dependent claims 3-8 follow suit. Appropriate correction is required.

The examiner interprets claims 2-8 as being drawn to a METHOD and not to an apparatus.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 2,3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most

nearly connected, to make and/or use the invention. As best as can be determined by the examiner this is a single step claim.

Such claims fail to comply with 35 USC 112 paragraph 1, as noted in ***O'Reilly v. Morse*** 56 US 62.

Claim 3, adds no additional step to its parent claim.

Claim 4 adds no additional step to its parent claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 2, 5, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) With respect to claim 2, the examiner cannot readily follow the wherein clause limitations. This clause appears to be a conclusion rather than add any additional steps. Further clarification is requested.

b) With respect to claim 5, the phrase "if the disk type cannot be known" is not understood. Further elaboration is requested.

c) With respect to claim 8, the examiner fails to follow what the phrase "registration of program reproduction" is attempting to define. Further elaboration is respectfully requested.

AS FAR AS THE CLAIMS RECITE POSITIVE LIMITATIONS AND AS INTERPRETED the following art rejections are made.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wehmeyer considered Ludtke et al and both further considered with Tanaka et al.

Wehmeyer discloses a disc access system and method wherein disc discrimination is predicated upon characteristics such as kind of disc. The disc is referred to as an audio cd, hence although a track number and a first type of disc are found; there is no second type of disc discrimination.

Ludtke et al discloses an av (audio video) system, wherein the system can discriminate between DVD's and cd's.

It would have been obvious to modify the base system of Wehmeyer and use the above additional disc discrimination motivation is to enable the system a greater flexibility and provide for various disc identification and use.

Tanaka et al further discloses in this environment the ability of "groups" in audio DVDs.

It would have been obvious to modify the base system of Wehmeyer and Ludtke et al and further modify such to encompass audio DVDs and hence enable a user to input "group" designation.

The examiner considers that the disc discrimination and requesting means are encompassed by the cooperation of the software and hardware attributes of the above systems and hence the apparatus limitations are met.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wehmeyer considered with Ludtke et al.

Wehmeyer discloses a disc access system wherein discs are accessed according to profiles wherein track number is part of the profile – see col. line 41 to col. 3 line 4.

Ludtke et al discloses an av system wherein various additional identifiers are relied upon in order to designate type of medium – see col 13 lines 38 plus with respect to DVD flags.

It would have been obvious to modify the base system of Wehmeyer with the above DVD flag to permit/increase the flexibility of Wehmeyer and encompass various types of different formatted discs.

8. Claims 3,4, 5, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 2 above, and further in view of Tanaka et al.

The examiner interprets these claims as a method claims that adds an additional step requiring "hierarchical structure" identification.

The examiner interprets the DVD audio formatting depicted by Tanaka et al as providing such.

It would have been obvious to modify the base system of Wehmeyer and Ludtke et al with the above additional dvd format discrimination, motivation is to further expand the overall systems ability to playback various types of DVDs, audio and well as video with associated audio information (such as various languages/chapter ids).

With respect to claim 5, the examiner interprets this claim as a method claim, which provides for the input of a certain data stream when "the disk type cannot be known". Because Ludtke et al establishes a set input sequence for the discs (irrespective of what type of disc) this meets the phrase "when the disk type cannot be known".

With respect to claim 6, the examiner interprets this claim as being met by the above combination of references, because the use of TOC's providing such managerial information is found in Tanaka et al. This toc data is stored upon reading the disc so as to be used for further system processing.

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 6 above, and further in view of Official notice.

The examiner interprets this claim as being drawn to a method describing DVD-RAM disc formats. Such formats are well known in this environment and Official notice is taken thereof.

It would have been obvious to modify the base system of references as relied upon with respect to claim 6 and further modify such to include DVD-RAM formats, motivation is again to expand the flexibility of the system so as to be compatible/playback the DVD-RAM discs.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 2 above.

The examiner interprets claim 8 as a method wherein when the user designates a track number, such as in Wehmeyer, such is registered (identified). This occurs when the above combined systems operate.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Katz et al and Fleming, III are cited as illustrative of disc playback systems – multimedia discs av discs.

Hard copies of the application files are now separated from this examining corps, hence the examiner can answer no questions that requires a review of the file without sufficient lead-time.

Any inquiries concerning missing papers/references, etc. must be directed to Group 2600 Customer Services at (703) 306-0377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (703) 305-6137. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2653

AMP